REMARKS

Responsive to the restriction requirement imposed in the Official Action mailed on March 15, 2005, applicants hereby provisionally elect Group I, claims 2-17 and 25-27, drawn to a compound targeted to a nucleic acid encoding metalloproteinase 12 (MMP-12), with traverse. As to the further restriction requirement pertaining to claims 7 and 8, applicants hereby provisionally elect SEQ ID NO. 5, with traverse.

As the Examiner is aware, there are two requirements for a proper restriction between patentably distinct inventions:

1) the inventions must be independent, or distinct as claimed; and

2) there must be a serious burden on the Examiner if restriction is required (see MPEP 803).

Upon reviewing the restriction requirement, applicants believe that the examination of all the claims pending in their full scope fails to place a serious burden on the Patent Office. All of the pending claims in the present application relate to antisense oligonucleotides targeted to the nucleic acid encoding MMP-12.

As a result, it is respectfully submitted that a search and examination of the oligonucleotides and their applications could be made without placing a serious burden on the Patent Office. Indeed, applicants respectfully submit that any search

for art relevant to Group I, Group II, Group III or Group IV would reveal all prior art relevant to the other groups.

In particular, applicants ask that Groups I and II be examined together. As acknowledged by the Official Action, the inventions of Group I and Group II are related as product and the process of using the product. The Official Action imposes the restriction requirement on the grounds that the compound of Group I can be used as a probe in *in situ* hybridization. As a result, the Official Action alleged that the product as claimed can be used in a materially different process.

However, while theoretically most probes can be used for *in situ* hybridization, most probes rarely work in practice. Indeed, in view of the length of the claimed oligonucleotides, it is believed that it is unlikely that the probe would be successful in *in situ* hybridization. Generally, a probe length of at least 50 base pairs is required for *in situ* hybridization. Thus, applicants believe that it is unlikely that the claimed sequences comprising 19 nucleotides could be used in a materially different process as identified by the Official Action.

As a result, applicants believe that it would not be an undue burden for the Examiner to search both Groups I and II.

Applicants also believe that the examination of all the sequences found in claims 7 and 8 fails to place an undue burden on the Patent Office. As acknowledged by the Official Action, an Examiner must examine all members of the Markush group if the

members are sufficiently a small number or so closely related that a search and examination of the entire claim can be made without a serious burden. Claims 7 and 8 comprise twelve related sequences. Each sequence comprises 19 nucleotides in length and target a limited portion of the MMP-12 sequence. As a result, applicants believe that an examination of the twelve related sequences fails to place a burden on the Patent Office.

Moreover, the Examiner's attention is respectfully directed to MPEP §803.04 which states that to further aid the biotechnology industry, without creating an undue burden on the Office, the Commissioner has decided to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such sequences to be claimed in a single application (See *Examination of Patent Applications Containing Nucleotide Sequences,* 1192 O.G. 68, November 19, 1996).

MPEP §803.04 then further provides that it has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined.

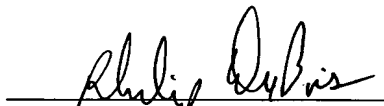
Thus, in view of the above, it is believed that an examination of all the sequences recited in claims 7 and 8 fails to place a burden on the Patent Office.

In view of the present response and the foregoing remarks, it is believe that applicants are entitled to an action on the merits of all of claims 1-33, in their full scope, in the present application. Such action is accordingly respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON



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